UNITED STATES CIRCUIT COURT OF APPEALS,

FOR THE NINTH CIRCUIT.

October Term, 1891.

Johnson Company, Appellant,
vs.
Pacific Rolling Mills Company, Appellee, } No. 33.

Johnson Company, Appellant,
vs.
Sutter Street Railway Company, Appellee, } No. 34.

BRIEF OF APPELLANT.

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SUTTER STREET RAILWAY COMPANY, *Appellee*. } No. 34.

APPEAL FROM THE U. S. CIRCUIT COURT, NORTHERN DISTRICT OF CALIFORNIA.

BRIEF OF APPELLANT.

STATEMENT OF THE CASE.

This is an appeal from the final decree dismissing the bills brought by the Johnson Company against the Pacific Rolling Mills and the Sutter Street Railway Company upon Letters Patent granted to Tom L. Johnson, February 20, 1883, No. 272,554, for a street railroad rail. The complainant (appellant) alleged that the respondents (appellees) infringed the fifth claim of said Letters Patent—the Pacific Rolling Mills Company, by reason of the manufacture and sale of a certain rail, and the Sutter Street Railway Company, by reason of the use of the same rail. A section of this rail is in evidence and marked "Complainant's Exhibit D." A drawing of this

section of rail is also in evidence and marked " Complainant's Exhibit E " (page 60, Appeal Record).

The patent in suit (shown in 42 *et seq.*, Appeal Record) says it has for its object:—

" The object of my invention is to improve the form of that class of railroad rails used principally by street railroads which combine the principal features of the tram-rail, ordinarily used for such purposes, and those of the T-rail used on steam railroads."

And the next line of the specification follows:—

" I am aware that rails embodying the general features above mentioned are old, and I therefore disclaim the same and confine myself to the form hereinafter particularly described and claimed as new."

The patent contains six claims, and an infringement was alleged against but one of these claims—the fifth—which reads as follows:—

" 5. In the combined tram and T-rail described, the web E, located relatively to the flange A and head B, offset at C, as described, whereby a maximum capacity of outside pocket is secured with a minimum quantity of metal consistent with the proper stability of the rail, substantially as set forth."

The Circuit Court, in an opinion filed by Judge Hawley, held that the claim did not involve invention and that respondents (appellees) did not infringe said claim, whereupon a decree was entered dismissing the bill, and this appeal was then taken, the appellant alleging the following errors, to wit:—

"*First.—The Circuit Court of the United States, for the Northern District of California, erred in the construction placed upon the fifth claim of the patent in suit.*"

It is contended that the Court erred in construing that the fifth claim of the patent in suit should be limited to a rail in which no part of the head projected directly over the line of the web of the rail (see opinion Hawley, J., page 60).

In order clearly to point out the position of the appellant upon this point, it will be necessary to again quote from the specification of the patent. The specification reads:—

"The object of my said invention is to improve the form of that class of railroad rails used principally by street railroads, which combine the principal features of the tram-rail ordinarily used for such purposes and those of the T-rail used on steam railroads.

I am aware that rails embodying the general features above mentioned are old, and I, therefore, disclaim the same and confine myself to the form hereinafter particularly described and claimed as new. * * * * In Figs. 1 and 2, the letter A indicates the flanged portion of the rail, B the head of the rail, C an offset under the head of the rail abutting the web on the side of said web opposite to that continued out into the flange, A. The web, E, extends from the foot, D, to the angles respectively formed on opposite sides by its union with the offset, C, and flange, A, thus securing a uniform depth of web proper for the fish-plates to clamp. * * * * A peculiar and important feature of this rail is the offset, C, which, while serving the purpose of a close fit for the splice-bar or fish-plate. * * * * The splice-bar offset, C, is a large factor in the proper retaining of this ballast, for it is large enough, with its square corner, in connection with the curved or arched shape of the lower part of the head and T-shaped foot to allow the surrounding and superincumbent traffic to press the ballast-gravel and stones of the street into and against the rail. * * * * By sweeping out the metal between the dotted line, L, and the true outline, *g*, *h*, *j*, Fig. 4, instead of carrying the curve from the point *g* to the outer edge, *j*, a freer flow of the small stone or looser ballast is permitted under the head and a more capacious pocket presented for its reception than would otherwise be the case. * * * * It will also be observed that this construction of rail permits of the under side of the head being made concave, which construction

secures a larger pocket for the retention of the ballast and a contour permitting of the more easy inflow of the adjacent ballast, as hereinafter described. * * * * "

The claim upon which suit is brought reads as follows :—

" In the combined tram and T-rail described, the web, E, located relatively to the flange, A, and to the head, B, offset at C, as described, whereby maximum capacity of outside pocket is secured with a minimum quantity of metal consistent with the proper stability of the rail, substantially as set forth."

Referring back to the specification above quoted, which, as can readily be seen, is that portion of the specification which relates to the claim quoted, insomuch as it is to that portion of the specification which is describing those parts of the rail and that construction of the rail which admits of a maximum capacity of outside pocket. In the print below, Fig. A is a copy of Fig. 4 of the patent in suit, included within

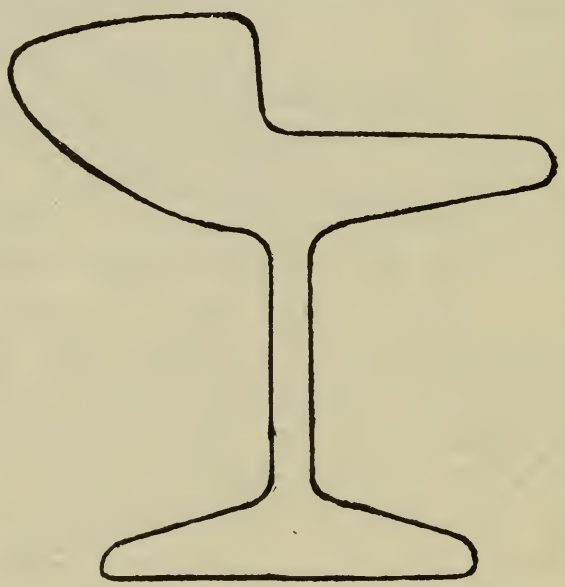

Fig. A.

the dotted line, L, and its full line continuation to the web.

Referring to that portion of the specification which treats of this figure, we quote the following :—

" By sweeping out the metal between the dotted line L and the true line *g h j*, a freer flow of the small stone or the looser

ballast is permitted under the head, and a more capacious pocket presented for its reception than would otherwise be the case."

Fig. B shows Fig. A above treated as described in the

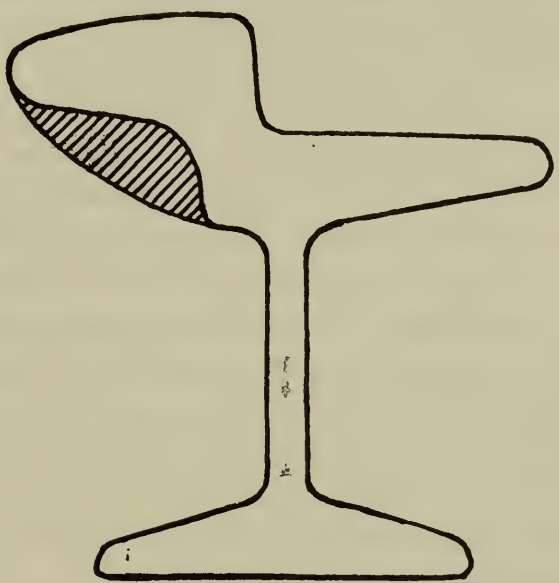

Fig. B.

patent, the section line portion indicating part to be cut away, and which would be confined within space bounded by lines L *gh j* (Fig. 4 of patent). Fig. C shows rail of patent

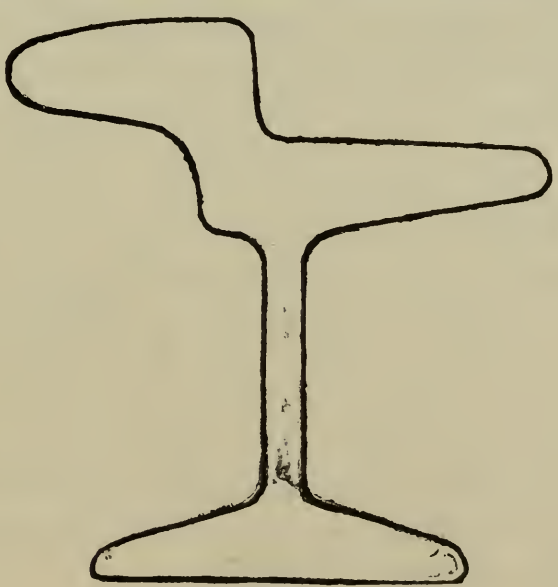

Fig. C.

(in this figure the sectional line portion of Fig. B has been removed).

It is evident that what is described in Fig. 4 of patent (as before stated, Fig. A of the above), is what the patentee means by his disclaimer and his statement of the object of his invention, which has been before quoted, the one following the other in the specification, so that, so far as this claim is concerned, it is contended that the invention therein claimed is for a rail which has the web, the flange and the head, the under part of the head being cut in a concave form until it strikes the fillet or projection C, when it convexes to the web, thereby providing a capacious pocket in which the ballast may lie, and also providing the fillet C, which enables even fish-plating and also performs such other functions as were alleged for it. The construction which was put upon this claim by the Court below added to the claim the limitation that the upper portion of the head of the rail, should project entirely to one side of the web.

The contention made by the appellant in reference to this position is that the 5th claim clearly shows that the purpose for which the particular invention, therein set out, was made was to enable a maximum capacity of outside pocket, to be obtained and that related, as the cuts will show, to the under side of the head of the rail; and so far as carrying out the purposes of that claim is concerned, it is immaterial whether the upper portion of the head extended to a point above the web or was wholly to one side of the web. It might have extended beyond the web so that the flange became almost infinitesimal, and yet it would not have affected the size of the outside pocket, provided the arrangements otherwise were as set out in that claim; that is, the under part head was cut away and its under side provided with the offset C, and the web, and the offset part of the head joined together as shown and described, and the web and the under side of the tram joined together as described.

The Circuit Court stated that a claim cannot be expanded beyond its clear meaning, irrespective of whatever the invention may be, which is undoubtedly sound; but where there is any ambiguity in the claim, the courts will construe the claim so as to preserve to the patentee his actual invention, as is stated in a late decision of the Supreme Court of the United States, *McLain* vs. *Ortmayer*, 141 U. S., 425:—

"It is true that in a case of doubt, where the claim is clearly susceptible of two constructions, that one will be adopted which will preserve to the patentee his actual invention."

And it is also equally well settled, as a proposition of law, that one claim cannot be so construed as to make that claim cover the same thing as claimed in another claim. (*Tondeur* vs. *Stewart*, 28 F. R., 561; *Cohansey Glass Manufacturing Company* vs. *Wharton*, 28 F. R., 189.)

Applying these doctrines to the claim in point, the purpose of the claim relates entirely to "whereby a maximum capacity of outside pocket is secured," etc.; and this purpose is satisfied by constructing the under side of the head as shown, and by having the juncture of the tram and offset C as shown; and the question of whether or not the upper portion of the head projected over the web in no way affects the carrying out of the purpose of this claim. Therefore, if this claim be vague, it certainly should be construed so as to cover that which enables it to perform its function, and no more. Again, if it be construed beyond the construction contended for, it will make said claim cover the same thing covered by other claims in the patent. Thus, if we compare this claim with the *second* claim of the patent, which reads as follows:—

"A combined tram and T-rail having the head B located with reference to the centre line of the web, reinforced as at C, and proportioned with reference to the flange A and the remaining parts of the rail, substantially as described, whereby the metal is distributed in the several parts, so as

to equalize contraction therein during the process of cooling, substantially as set forth."

It will be seen that if the limitation is read into *claim 5*, that the head B is to be located entirely to one side of the central line of the web, and omit the purposes set out in the claim, then this added limitation to *claim 5* will make *claim 5* exactly the same as *claim 2*, as that limitation is the one point of difference between the two claims. If we refer to the specification, we can see that the offset C, while accomplishing the purpose set out above with respect to *claim 5*, permits an additional function which is made the basis of *claim 2*, to wit: it permits the mass of metal in the upper part of the head above the web to be removed so as to reduce the total mass of metal in the head to equalize the draft to insure the rails leaving the rolls straight. To equalize contraction in cooling, the head at the top must be located to one side of the web, and this is permitted by reason that the construction claimed in *claim 5* necessitates sufficient metal being at the part C. *Claim 2* simply refers to the fact that the rail has the part C, but does not make that the essence of the claim. The distribution of the metal in the upper part of the head and the arrangement of that part to one side of the web being the essence of the claim.

Again, if *claim 5* be read as construed by the lower Court, there could be no other construction given to *claim 2* than exactly that which is given to *claim 5;* and, therefore, it can undoubtedly be said that, at the least, *claim 5* is not clear, and that the construction of the claim is one which comes under the ruling in *McLain* vs. *Ortmayer*, *ante*. Such being the case it would not be proper to so construe that claim as to make it read the same as any other claim in the same patent.

Second.—The Circuit Court of the United States, for the Northern District of California, erred in failing to find that defendant's (appellee's) rails infringed the fifth claim of the patent in suit.

The defendants' rail is shown in the drawing, page 60 of the Appeal Record, and on page 27 of the Defendants' Record, is a comparison sworn to by complainant's expert, of defendants' rail and the patented rail. If the construction which the appellant contends for be correct, a glance at these two diagrams will show that the relation of the web of the rail to the under face of the tram and the under face of the head is the same, and that the under face of the head is offset, as in the patented rail. Irrespective of the difference in size of the rails, one is almost a Chinese copy of the other. If we apply the same analysis to defendants' rail that we did to the patented rail, Fig. D represents defendants' rail with

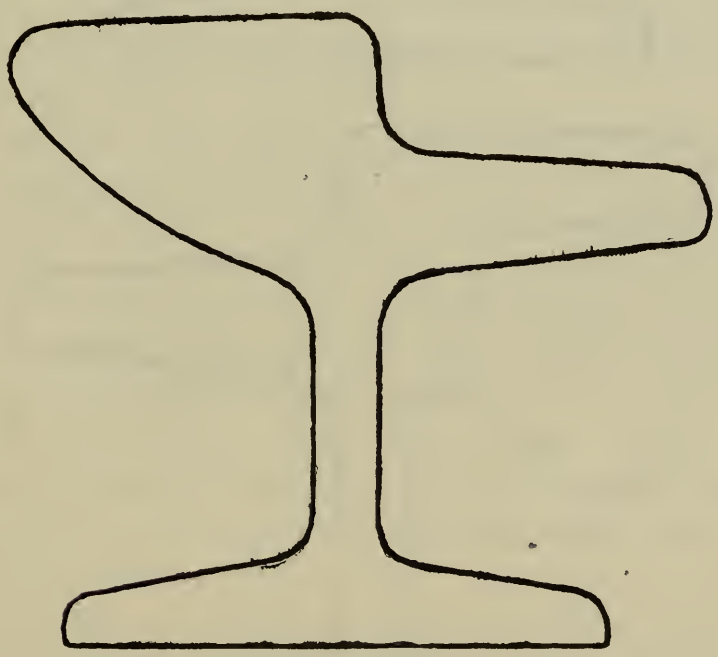

Fig. D.

the head carried as described in reference to Fig. A (*ante*, page 4), which represents Fig. 4 of the patent in suit before the patentee's change had been made. If we do to this Fig. D exactly what the patentee described with reference to Fig. 4 of the patent, that is, cut away the cross-section lines of Fig. E, we will obtain the defendants' rail, Fig. F, so

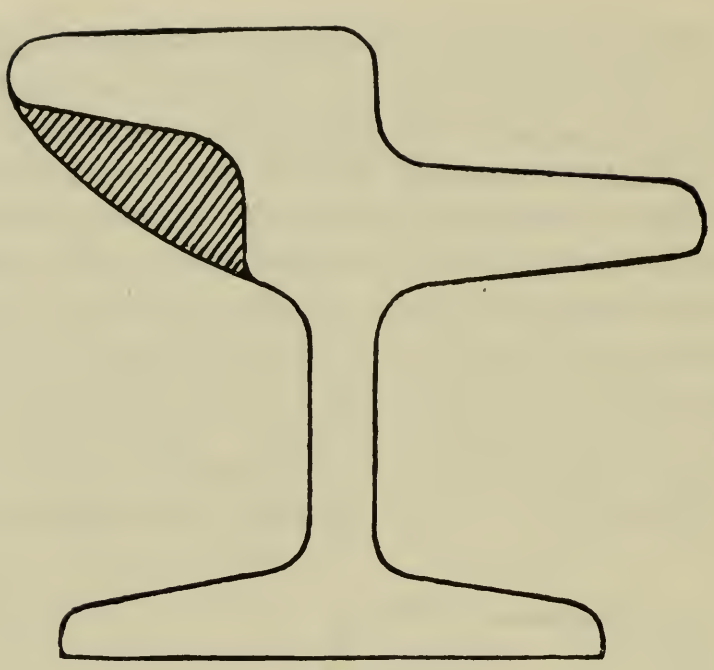

Fig. E.

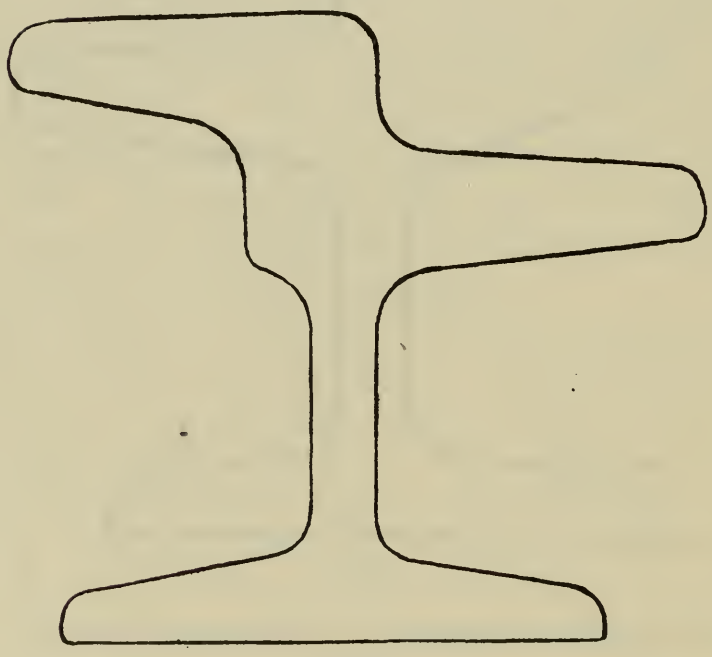

Fig. F.

that, so far as the purposes for which claim 5 was made, these defendants have performed, upon the prior rail admitted to be old in the patent in suit just exactly that which the patentee did, and has arrived at exactly the same result. It

is true that in the case of the defendants' rail, the upper portion of the head extends above the web line; but this in no way affects or modifies the pocket capacity of the rail, and the purpose of the offset as claimed will be found in the construction of the under side of the head and the juncture of the offset C and tram with the web. It was admitted by Noble, the superintendent of the Pacific Rolling Mills, that they had an offset in their rail, and that offset was put in there for the purpose of making even fish-plating (+ Q. 13 and 14, page 36, Appeal Record); and it is evident that defendants' rail obtains a greater pocket capacity than the rail admitted to be old in the patent, which is illustrated in Fig. A, page 4, *ante;* for Noble says, in answer to Q. 20, page 32: "If the curve *j-h* were continued around in a true curve it would afford a better pocket, so that in that respect we look upon offset C as a defect."

So that, from this statement, there is no doubt that doing as the patentee did—cutting off the dotted line L from the rail, admitted to be old in the patent—enabled a greater pocket capacity to be obtained. There can thus be no doubt that if the construction that appellant contends for be the correct construction of the claim, the defendants' (appellees') rail must be held to be an infringement.

Third.—The Circuit Court of the United States, for the Northern District of California, erred in holding that there was no invention over the prior art in the matter claimed in the fifth claim of the patent in suit.

The question as to what constitutes invention has formed the subject-matter of a large number of cases decided by the Supreme Court, in some of which the inventions have been sustained, and in a number of which the patents have been declared invalid for want of invention. In a late case decided by the Supreme Court (*McLain* vs. *Ortmayer*) it was stated:—

"What shall be construed as invention within the meaning of the patent laws has been made the subject of a great

amount of discussion in the authorities, and a large number of cases, particularly in the more recent volumes, turn solely upon the question of novelty. By some, invention is described as the contriving or constructing of that which had not before existed; and by another, giving a construction to the patent law, as 'the finding out, contriving, devising or creating something new and useful, which did not exist before, by an operation of the intellect.' To say that the act of invention is the production of something new and useful does not solve the difficulty of giving an accurate definition, since the question of what is new as distinguished from that which is a colorable variation of what is old, is usually the very question in issue. To say that it involves an operation of the intellect is a production of intuition, or of something akin to genius, as distinguished from mere mechanical skill, draws one somewhat nearer to an appreciation of the true distinction, but it does not adequately express the idea. The truth is, the word cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case we may be able to say that there is present invention of a very high order. In another we can see that there is lacking that impalpable something which distinguishes invention from simple mechanical skill. Courts, adopting fixed principles as a guide, have, by a process of exclusion, determined that certain variations in old devices do or do not involve invention; but whether the variation relied upon in a particular case is anything more than ordinary mechanical skill is a question which cannot be answered by applying the test of any general definition."

Applying this to the case at point, and recollecting that this is an article of manufacture and is not for a combination of elements, the question of aggregation or combination does not enter into the question; but the question is whether the thing claimed does perform some function or use which did not exist in prior structures. The prior art in this case is

represented by the T-rail, the California street rail, and the rail admitted to be old in the patent in suit. The T-rail was a rail in which the head projected but just enough on each side of the web to allow sufficient bearing for the tread of the wheel. The rail described as old in the patent in suit is shown in Fig. A, page 4, *ante*, and the California street rail is shown below, Fig. G. This California street rail undoubt-

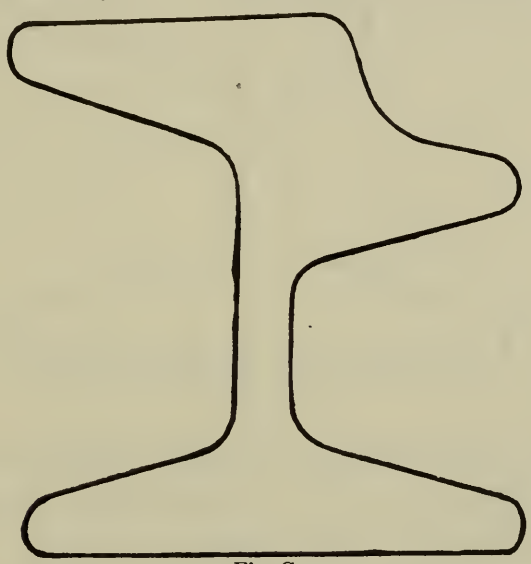

Fig. G.

edly had a large pocket capacity, but it differs from the patented rail and from defendants' rail in exactly the same particular, in lacking the offset C. Fig. H represents the

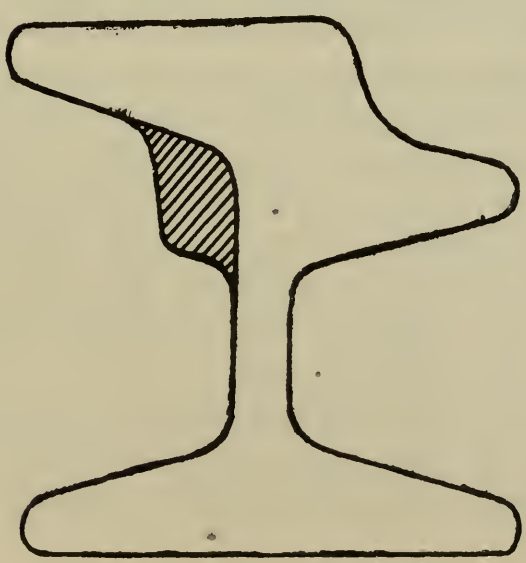

Fig. H.

California street rail with the offset C, and Fig. J represents Fig. H with section lines removed. The purpose of this

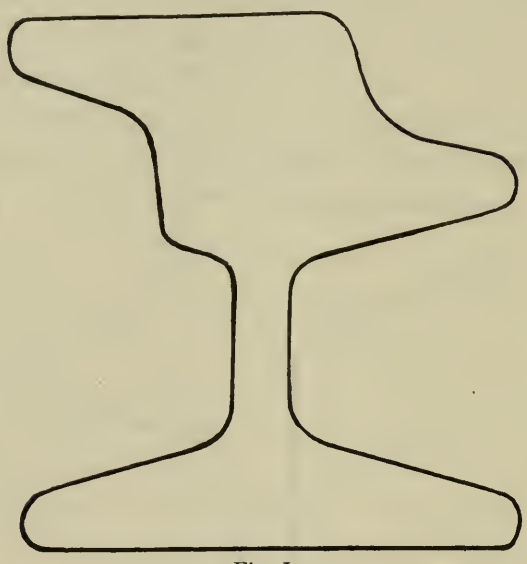

Fig. J.

offset C in this type of rail enabled a maximum capacity of pocket to be obtained, and at the same time allowed the rail to be even fish-plated. The California street rail obtained the maximum capacity of pocket with the loss of the adaptability for even fish-plating, while the rail admitted to be old in the patent in suit had adaptability for even fish-plating, and sacrificed pocket capacity by so doing. Thus, if we suppose the rail admitted to be old in the patent in suit were a rail prior to the California street rail, in order to obtain a greater pocket capacity for the ballast, the whole under side of the head was cut away, for, as the witness Noble says, in answer to Q. 21, page 33 : " If he had taken (speaking of the patent) the rail made for the California street road, which was well known when his patent was taken out * * * * because the old California street rail furnishes a better pocket, the offset C being an obstruction."

But in using this California street rail, which has never been used in any other place than in California, even fish-plating was impossible, and the pocket capacity was obtained

by the sacrifice of this important feature. So the patentee in this suit devised the rail claimed in this claim of the patent in suit, which was to have the pocket capacity of the California street rail, and at the same time be so arranged, by reason of the use of the offset, as to enable even fish-plating, thus forming a rail that had greater capacities than any other rail preceding it in the art. The T-rail, to be sure, enabled even fish-plating, and its only effect in this discussion seems to be to show the advantage of even fish-plating. For this T-rail was symmetrical, so far as its head is concerned, and its head projected only sufficiently, as before stated, on each side of the web only sufficient to form a tread for the car wheel, but in no way formed, or had the capacity to form, any pocket. Therefore it can have but little bearing upon this matter. The California street rail is really a retrograde movement from the rail admitted to be old in the patent in suit; for the defendants themselves admit that even fish-plating is essential, and the very purpose for which they put their fillet under the head. The California street rail was open to them for use, and instead of adopting and using that rail, if the contention before set out in reference to the construction of the claim of the patent in suit be correct, the defendants made a Chinese copy of plaintiff's patented rail, and obtained exactly and every advantage which is obtained for said rail in the claim.

It is admittedly true that change of form, without accomplishing any new result, is not invention; but where the change of form, as in this case, accomplishes, in a single structure, that which had never been accomplished before in a single structure, invention undoubtedly exists. It must be recollected that, in these cases, a single structure, in each case, is the only thing that could be used. Thus, in the rail of the patent in suit, substantially all the pocket capacity of the California street rail is obtained, and at the same time the capacity for even fish-plating possessed by the rail admitted to be old in the patent and by the T-rail, is obtained; but in

no one of the prior rails were these capacities obtained in one single structure.

Fourth.—The Circuit Court erred in dismissing the bill of complaint. If the foregoing grounds urged be sound, appellant respectfully submits that the decree of the Circuit Court should be reversed and a decree entered for complainant as prayed for in the bill of complaint.

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